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APPLICATION NO.	FILING DATE	FIRST NAME/INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SRIVASTAVA, KAILASH C

ARTICLE PAPER NUMBER

1681

DATE MAILED: 01/08/2003

Please find below and or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/023,362

Applicant(s)

LAN ET AL.

Examiner

Dr. Kailash C. Srivastava

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/14/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1. ☐ Notice of References Cited (PTO 413)  
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO 448)  
3. ☐ Information Disclosure Statement(s) (PTO 444) (Page No. \_\_\_\_\_)  
4. ☐ Interview Summary (PTO 413) (Page No. \_\_\_\_\_)  
5. ☐ Notice of Informal Patent Application (PTO 452)  
6. ☐ Other \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1-49 are pending.

### ***Election /Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Group I, consisting of claims 1-22 drawn to a method to cultivate an organism, classified in Class 424 subclass 439, for example.
  - Group II, consisting of claims 23 and 27-49 drawn to a composition, classified under Class 435, subclass 41, for example.
  - Group III, consisting of claims 24-26 drawn to a method, classified under Class 435, subclass 243 or 352.1, for example.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions encompassing claims in Groups I-II are unrelated to inventions in Group III because they are directed to different inventions that are not connected in design, operation and/or effect. These methods are independent since they are not disclosed as capable of use together. They have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the procedures encompassed in each one of the inventions of Groups I-II and III at the same time to practice just one invention alone (MPEP § 806.04, MPEP § 808.01). In the instant case, for e.g., different inventions disclosed in the claims encompassing inventions in Groups I and III are methods to culture a microorganism. However, the method encompassing claims in invention of Group I would not necessarily also make the product obtained by practicing the method claimed in Group III.

Invention in Group II is related to invention in Group I as product and process to make the product. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the method to prepare the fruiting body can also be applied to prepare a fermentation product (e.g. a chemical compound, or a pharmaceutical). The compositions claimed in Invention of Group II may also be prepared by different methods, for example composting.

The inventions discussed above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each one of the above inventions is not coextensive particularly with regard to the literature search. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (i.e., class and subclass), and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.

4. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (703) 605-1196. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743 Monday through Thursday. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Kailash C. Srivastava, Ph.D.  
Patent Examiner  
Art Unit 1651

January 7, 2003